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REMARKS

The Applicant has carefully read and reviewed the Office Action mailed June 16, 2004, and the references cited therewith. Claims 1, 2, 4, 5, 8-13, 15, 17, and 25-42 were rejected. No Claims have been amended or canceled in this Response. Claims 1, 2, 4, 5, 8-13, 15, 17, and 25-42 are pending in the application.

Rejections under 35 U.S.C. §103

Claims 1, 2, 4, 8-13, 15, 17, 25-36, and 38-42 were rejected under 35 U.S.C. 103(a) as being unpatentable over Smith (US 6,384,995), in view of Abraham et al. (US 5,527,110).

Applicant respectfully traverses the rejections under 35 U.S.C. 103(a). To establish a *prima facie* case of obviousness, three basic criteria must be met. First, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Second, there must be a reasonable expectation of success. Third, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. See M.P.E.P. 2143 and 35 U.S.C. 103.

Independent Claims 1, 25 and 32, all clearly describe methods or apparatuses that image a characteristic size of a defective region based on a plurality of readback signals. With respect to these Claims, none of the aforementioned criteria of a *prima facie* case of obviousness have been met.

Particularly, there is no suggestion or motivation to combine the references. Abraham does not suggest that a thermal asperity imaging be combined with the neural network detecting of Smith. In fact, Abraham actually teaches away from Smith's implementation of detecting defects. As is well known, a reference that "teaches away" can not serve to create a *prima facie* case of obviousness. In re Dillon, 13 USPQ2d 1337 (CAFC 1989)

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Specifically, Smith only teaches detecting media defects using neural networks. Meanwhile, Abraham uses thermal imaging through electronics and hardware means, without even discussing neural networks. Thus, Abraham teaches away from Smith by thermal imaging without the use of neural network detecting. There is no suggestion in neither Smith nor Abraham, or in the knowledge generally available to one of ordinary skill in the art, to combine these two references.

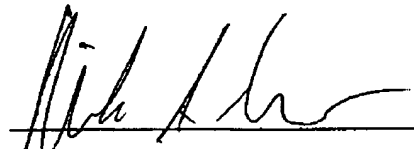
For the aforementioned reasons, claims 1, 25, and 32 are believed to be patentable over the prior art of record. Claims 2, 4, 5, 8-13, 15, 17, 26-31, and 33-42 are dependent claims which ultimately depend from claim 1, 25 or 32, all of which are believed to be patentable over the prior art of record for the reasons discussed hereinabove. Claims 2, 4, 5, 8-13, 15, 17, 26-31, and 33-42 are thus allowable as dependent claims depending from allowable independent claims and providing additional limitations thereto.

Reconsideration and withdrawal of the rejection of claims 1, 2, 4, 5, 8-13, 15, 17, and 25-42 is respectfully requested. Applicant respectfully asserts that the present claims particularly point out and distinctly claim the subject matter which is regarded as the invention.

It is respectfully submitted that the pending claims are in condition for allowance, and favorable action with respect to the present application is requested.

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Kirk A. Cesari, Reg. No. 47,479

Seagate Technology LLC

1280 Disc Drive - SHK2LG

Shakopee, MN 55379-1863

Telephone: 952-402-3534